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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/230,623	06/14/1999	STEPHEN MAY	P98.3235	4102

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EXAMINER

WEINSTEIN, STEVEN L

ART UNIT PAPER NUMBER

1761

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/230,623

Applicant(s)

MAY ET AL.

Examiner

Steven L. Weinstein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

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Upon reconsideration, and in view of the patenting of application 09/230622 as U.S. Patent No. 6,582, 740, which patent has claims which are obvious variants of the claims in this pending application, an obvious double patenting rejection is warranted. Therefore, the final rejection mailed 2/7/03 is hereby withdrawn and a new non-final Action follows.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the ground of obvious type double patenting as unpatentable over the claims in U.S. patent No. 6,582, 740. In regard to claim 1 of the pending application, claim 1 of U.S. Patent No. 6,582,740 discloses a canned pet food comprising a base layer comprising solid food pieces in a gravy wherein the gravy comprises about 20% to about 40% by weight of the base layer and an upper layer comprising a substantially solid food stuff capable of supporting the base layer when the pet food is inverted and wherein the substantially solid food stuff comprises about 20% to about 80% by weight of the pet food product. This is all that pending claim 1

positively recites. It is noted that claim 1 of US patent '740 also discloses the base layer has a conical recess but claim 1 of the pending application is a comprising claim and does not specify any particular shape to the base layer. In regard to pending claims 2,3,4,6 and 7, claims 3,4,5,6, and 7 of U.S. Patent '740 teach the striated appearance; flakes; about 2 to about 8% water in the gravy; about 60% to about 70% by weight; and the various solid food stuffs, respectively. In regard to pending claim 5, the claims of US patent '740 teach that the particular viscosity of the gravy would have been an obvious determination if not already inherent in the recited properties. In regard to claim 8 of the pending application, the claims of US patent '740 teach the moisture content of the upper layer would have been an obvious determination if not already inherent in the properties recited. In regard to pending claim 9, claim 9 of U.S. Patent '740 recites a range including that recited. In regard to pending claim 10, pending claim 10 is considered to be the obvious method of making the product of the claims recited in U.S. Patent '740. The examiner takes notice of the fact that retorting sealed cans is notoriously conventional.

It is noted that there is at least one additional pending application that is either the same inventive entity, or at the minimum, commonly assigned which has been allowed but not yet published. This is application S.N. 10/035691 which is not presently available to the examiner. The examiner has reason to believe the current pending application would also warrant consideration of obvious type double patenting rejections

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over S.N. 10/035691. Applicants are asked to review this issue and to furnish the examiner a copy of the allowed claims from S.N. 10/035691.

Also, since Application S.N. 09/230,622 and Application S.N. 09/230,623 were not cross referenced in their respective specifications and since it is the examiners impression that there are more applications with similar layered canned pet food concepts, applicants^{are} requested to furnish the USPTO with a list of all related applications relating to canned layered pet food so that determinations can be made relatively to double patenting issues and conflicting claims and pertinent art.

Claims 1-10 are rejected under 35USC 103(a) as being unpatentable over Ohba ('252) in view of Poppel et al ('504) and applicant s' admission of the prior art or vice versa, that is Poppel et al and applicants admission of the prior art in view of Ohba, further in view of Waldburger ('254), McGonigle ('174), Cease ('537), Bliley ('086), Stover ('245), Rogers et al ('094) and Docker (EP 361893), further in view of Quaker Oats (GB'351), QP CORP (Jp '677), Qp corp (Jp ' 174), Errass (Ep'046) and Henckel (GB '234) for the reasons detailed in the Office action mailed 8/29/00, 4/3/01/, and 7/31/02.

Thus, the rejection on art under 35 USC 103 (a) is maintained. The art taken as a whole teaches it is notoriously old to provide packaged multiple distinct layers of different products wherein the layers are maintained separate due to viscosity control, change of state such as freezing, etc. Although the art taken as a whole does not specifically teach a base layer in a can containing solid pieces and a gravy, the art taken as a whole is considered to be a general teaching that any product can be

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maintained in a distinct separate layer from another layered product if the product is sufficiently comparable in viscosity to the other layer or is frozen. That is, the art taken as a whole teaches it would have been obvious to treat any product to provide maintenance of layers in a can. However, what the art taken as a whole does not appear to teach, but what is also not claimed, is a retorted layered canned pet food and process of making that at initial filling and due to the density and viscosity of the mixture of the solid food pieces and gravy, and the density and viscosity of the settable food off, clear and distinct layers are formed in the can with the upper layer being on the lower layer and wherein the retorted can contains a base layer that comprises solid food pieces and a gravy that is thin and runny (page 8, paragraph. 3 and 4), that is one that is easily flowable, that has had its viscosity decreased due to the heat during retorting, and an upper layer of the substantially solid foodstuff, which retorted layers maintain their clear and distinct configuration. As noted above, support for these concepts comes directly from page 8 paragraph 2 and 3 of applicants specification. An amendment adding these concepts to claims 1 and 10 would place this application in condition for allowance if filed with a proper terminal disclaimer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Weinstein whose telephone number is (571) 272-1410. The examiner can normally be reached on Monday-Friday 7:00am to 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

S.Weinstein/af
January 30, 2004


STEVE WEINSTEIN
PRIMARY EXAMINER 1761
Rem 8A69
2/2/04